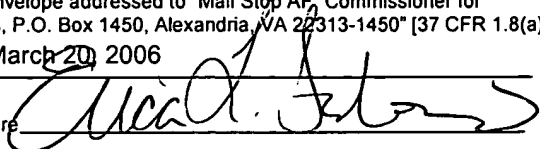
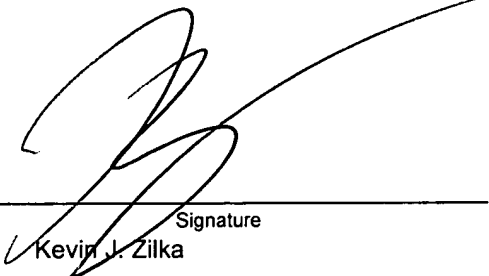


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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) NAI1P484/01.103.01 | |
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| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 20, 2006</u> Signature <u></u> Typed or printed name <u>Erica L. Farlow</u> | Application Number 10/028,906 | Filed 12/28/2001 | |
| | First Named Inventor N. Kelly et al. | | |
| | Art Unit 2131 | Examiner Laforgia, C. | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div><div><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. 41,429 Registration number _____</p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div><p>Signature Kevin J. Zilka</p><p>Typed or printed name (408) 971-2573</p><p>Telephone number 3/24/06</p><p>Date</p></div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has rejected Claims 1-13 under 35 U.S.C. 101 as being non-statutory, since such claims allegedly represent a computer listing *per se*, that is, non-functional descriptive material, etc. Applicant respectfully disagrees. Specifically, applicant clearly claims a “computer program product for operating a computer to review files for potential malware” (emphasis added), clearly a functional set of acts being performed.

The Examiner has rejected Claims 1-2, 7-12, 14-15, 20-25, 27-28 and 33-38 under 35 U.S.C. 103(a) as being unpatentable over Chess et al. (U.S. Patent No. 6,711,583) in view of Smithson et al. (U.S. Patent No. 6,886,099). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has responded to applicant’s arguments with respect to applicant’s claimed “logging code operable to maintain a statistical log having an entry for each file sent to the computer for review, each entry being arranged to store a count value indicating the number of times that the file has been sent to the computer for review and a value of one or more predetermined attributes relating to the file” (see this or similar, but not necessarily identical language in each of the independent claims).

Specifically, the Examiner has stated that the Abstract of Smithson teaches “the tracking for a number of times a file is sent for review.” Applicant respectfully asserts that the Abstract in Smithson only discloses measuring “how many E-mail messages are sent having an identical file attachment, the file type or simply in total.” Clearly, measuring how many E-mail messages are sent, as in Smithson, does not meet applicant’s specific claim language, namely “stor[ing] a count value indicating the number of times that the file has been sent to the computer for review” (emphasis added), as claimed.

In addition, the Examiner has stated that Col. 5, lines 5-48 in Chess teach “keeping a value of one or more predetermined attributes relating to the file, such as whether the file is safe or questionable.” First, applicant respectfully asserts that such excerpt in Chess only teaches “examin[ing] documents in the collection on disk,” and not “a statistical log having an entry for each file sent to the computer for review,” as applicant claims (emphasis added). Second, Chess merely discloses storing “the document name and macro data” associated with the document, where the macro data is the names of any macro data stored in the document. Clearly, such data does not meet applicant’s claimed “value of one or more predetermined attributes relating the file” (emphasis added). Thus, in view of the above arguments, applicant respectfully asserts that neither Smithson nor Chess meet applicant’s specific claim language.

Still with respect to each of the independent claims, the Examiner has responded to applicant’s claimed “weighting indicating the likelihood that a file having that value of said one or more predetermined attributes will be malware” and “referenc[ing] the weighting table to determine the weighting to be associated with the file, based on the value of said one or more predetermined attributes associated with that file in the statistical log” (see this or similar, but not necessarily identical language in each of the independent claims).

Specifically, the Examiner has argued that “Chess discloses a technique for determining the likelihood of a file being infected by the addition or change of code since the last time the file has been reviewed” (Col. 5, lines 5-48). Applicant respectfully asserts that simply comparing macro data to determine if “safe” changes or “questionable” changes have occurred, as in Chess, does not even suggest any sort of weighting table. Instead, Chess teaches that “removing one or more macros from the document could be considered ‘safe’, whereas the modification or addition of macros to the document could be considered ‘questionable’.”

Thus, Chess determines whether a document has safe or questionable changes made to it based on whether a change involved the removal or addition of macros, which

clearly does not even suggest the utilization of a weighting table, and especially not in the context claimed by applicant. In addition, since Chess does not disclose storing any sort of value of one or more predetermined attributes relating to the file, in the manner claimed by applicant, Chess simply would not utilize a weighting table for determining the weighting to be associated with the file, based on the value of said one or more predetermined attributes associated with that file, as applicant specifically claims.

Still with respect to each of the independent claims, the Examiner has failed to responded to applicant's arguments with respect to applicant's claimed "statistical log interface code operable, upon receipt of a file, to determine with reference to the statistical log the count value relating to that file; action determination code operable, if the count value determined by the statistical log interface code exceeds a predetermined threshold" (see this or similar, but not necessarily identical language in each of the independent claims). In particular, the Examiner has merely stated that "the combination of [Smithson and Chess] disclose referencing a weighting table to determine the weighting to be associated with the file, based on the value of said one or more predetermined attributes associated with that file in the statistical log."

Applicant respectfully asserts that what is claimed is "determin[ing] with reference to the statistical log the count value relating to that file" (emphasis added). For substantially the reasons argued above, applicant emphasizes that neither Chess nor Smithson teach any sort of value in the context claimed by applicant, and thus it is impossible for the references to teach a situation where "upon receipt of a file...determin[ing] with reference to the statistical log the count value relating to that file," as claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the Examiner has failed to respond to applicant's arguments with respect to dependent Claim 11 et al. Applicant again notes that the Examiner has relied on the following excerpts from the Smithson reference to make a prior art showing of applicant's claimed "each entry in the statistical log ... further arranged to identify, for each sender of that file, the number of times that that sender has sent the file in addition to the count value indicating the total number of times that the file has been sent" (see this or similar, but not necessarily identical language in each of the independent claims).

"As preferred examples of the measurement parameters that may be used there are proposed:

1. How many E-mail messages are sent having an identical message title.
 2. How many E-mail messages are sent identical file attachment.
 3. How many email messages are sent having a file attachment of a given file type.
 4. How many E-mail messages are sent having a file attachment that is an executable file.
 5. The E-mail throughput put within the computer system.
 6. The E-mail throughput measured in a form dependent upon a number of E-mails multiplied by a total size for the E-mails."
- (Col. 4, lines 25-40)

Again, as noted above, Smithson's measurement parameters and thresholds are associated with aggregate file activity, and not a particular file. To this end, Smithson simply fails to meet applicant's claimed "number of times that that sender has sent the

file in addition to the count value indicating the total number of times that the file has been sent.” It is further noted that the measurement parameters does not track a per-sender number, and thus fails to meet applicant’s claimed “each entry in the statistical log ... further arranged to identify, for each sender of that file, the number of times that that sender has sent the file in addition to the count value indicating the total number of times that the file has been sent” (emphasis added).

Thus, only applicant teaches and claims use of both 1) a number of times that a particular sender has sent a file, and 2) a total number of times the file has been sent *irrespective of sender* in each entry in the statistical log. Note Table 1 below which illustrates such claimed subject matter.

Table 1

Entry_1 (associated with file_1)

Sender_1

Number of times file_1 is sent by Sender_1

Sender_2

Number of times file_1 is sent by Sender_2

Total number of times file_1 is sent

Entry_2 (associated with file_2)

Sender_1

Number of times file_2 is sent by Sender_1

Sender_2

Number of times file_2 is sent by Sender_2

Total number of times file_2 is sent

Again, a notice of allowance or a specific prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.